

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

ARTHROCARE CORPORATION,

Plaintiff,

v.

SMITH & NEPHEW, INC.

Defendant.

C.A. No. 01-504-SLR

SMITH & NEPHEW, INC.,

Counterclaim Plaintiff,

v.

ARTHROCARE CORPORATION, AND
ETHICON, INC.,

Counterclaim Defendants.

SMITH & NEPHEW'S NOTICE PURSUANT TO 35 U.S.C. § 282

Defendant Smith & Nephew, Inc. ("Smith & Nephew") hereby provides its written notice pursuant to 35 U.S.C. § 282 of the patents and publications that it may rely upon to anticipate, render obvious or show the state of the art with respect to United States Patent No. 5,697,536 ("the '536 patent"), 5,697,882 ("the 882 patent"), and 6,224,592 ("the '592 patent"). Smith & Nephew may also rely on the persons listed below as being prior inventors or having prior knowledge of or as having previously used or offered for sale the inventions of the patents-in-suit. Smith & Nephew also incorporates by reference the items set forth in its responses to Plaintiff's Interrogatories and in the expert reports of Dr. Kenneth Taylor, Dr. Michael Choti, Dr. Kim Manwaring and Ronald Panitch, Esq.

Furthermore, in light of the recent filings by the parties on proposed claim construction, Smith & Nephew reserves the right to further supplement this notice depending on the Court's ruling on claim construction and/or possible new claim constructions.

I. PRIMARY REFERENCES RELIED UPON

A. PATENTS

	Country	Patent No.	Date	Name of Patentee
(1)	US	2,056,377	10/6/36	Wappler
(2)	US	3,815,604	06/11/74	O'Malley et al.
(3)	US	3,828,780	8/13/74	Morrison, Jr.
(4)	US	3,901,242	8/26/75	Storz
(5)	US	3,920,021	11/18/75	Hiltibrandt
(6)	US	3,939,839	2/24/76	Curtiss
(7)	US	3,970,088	7/20/76	Morrison
(8)	FR	2,313,949 No. 76 17587	1/7/77	Hiltibrandt, et al.
(9)	US	4,074,718	2/21/78	Morrison, Jr.
(10)	US	4,092,986	6/6/78	Schneiderman
(11)	US	4,116,198	9/26/78	Roos
(12)	US	4,181,131	1/1/80	Hisao Ogiu
(13)	US	4,184,492	1/22/80	Meinke et al.
(14)	US	4,232,676	11/11/80	Herczog
(15)	US	4,248,231	2/3/81	Herczog et al.
(16)	US	4,326,529	4/27/82	Doss et al.
(17)	US	4,381,007	4/26/83	Doss
(18)	US	4,548,207	10/22/85	Reimels
(19)	US	4,590,934	5/27/86	Malis et al.
(20)	US	4,660,571	4/28/87	Hess et al.
(21)	US	4,674,499	6/23/87	Pao
(22)	US	4,785,823	11/22/88	Eggers et al.
(23)	US	4,805,616	2/21/89	Pao
(24)	US	4,823,791	4/25/89	D'Amelio et al.
(25)	US	4,832,048	5/23/89	Cohen
(26)	WO	90/03152	4/5/90	Considine et al.
(27)	US	4,920,978	5/1/90	Colvin
(28)	US	4,931,047	6/5/90	Broadwin et al.
(29)	US	4,936,281	6/26/90	Stasz
(30)	US	4,966,587	10/30/90	Cosman
(31)	US	4,976,711	12/11/90	Parins et al.

	Country	Patent No.	Date	Name of Patentee
(32)	US	4,979,948	12/25/90	Geddes et al.
(33)	DE	3930451 A1	3/21/91	Hoffmann et al.
(34)	US	5,007,908	4/16/91	Rydell
(35)	US	5,009,656	4/23/91	Reimels
(36)	US	5,035,696	7/30/91	Rydell
(37)	US	5,047,026	9/10/91	Rydell
(38)	US	5,047,027	9/10/91	Rydell
(39)	US	5,080,660	1/14/92	Buelna
(40)	US	5,084,044	1/28/92	Quint
(41)	US	5,085,659	2/4/92	Rydell
(42)	US	5,088,997	2/18/92	Delahuerga et al.
(43)	US	5,098,431	3/24/92	Rydell
(44)	US	5,108,391	4/28/92	Flachenecker et al.
(45)	US	5,112,330	5/12/92	Nishigake et al.
(46)	US	5,122,138	6/16/92	Manwaring
(47)	US	5,167,659	12/1/92	Ohtomo et al.
(48)	US	5,171,311	12/15/92	Rydell et al.
(49)	US	5,197,963	3/30/93	Parins
(50)	US	5,207,675	5/4/93	Canady
(51)	US	5,217,459	6/8/93	Kamerling
(52)	US	5,306,238	4/26/94	Fleenor
(53)	US	5,432,882	6/13/95	Jackman et al.
(54)	US	5,454,809	10/3/95	Janssen
(55)	US	5,496,314	3/5/96	Eggers

B. PUBLICATIONS

	Author	Article Title	Source & Page Nos.	Date
(1)	Leonard I. Malis, M.D.	Bipolar Coagulation in Microsurgery	<i>MicroVascular Surgery</i> , 126-131	1967
(2)	A.K. Dobbie	The Electrical Aspects of Surgical Diathermy	<i>Bio-Medical Engineering</i> 206-216	5/69
(3)	Honig	The Mechanism of Cutting in Electrosurgery	<i>IEEE Transactions On Biomedical Engineering</i>	1/75
(4)	Elasser and Roos	Uber ein Instrument zur leckstromfreien transurethralen Resection (Concerning An Instrument for Transurethral Resection Without Leakage of Current)	<i>Acta Medico Technica</i> (Medizinal-Markt), Vol. 24, No. 4, 129-134	1976

	Author	Article Title	Source & Page Nos.	Date
(5)	Piercey, M.D., et al.	Electrosurgical Treatment of Experimental Bleeding Canine Gastric Ulcers: Development and testing of a computer control and a better electrode	<i>Gastroenterology</i> , Vol. 74, No. 3, 527-534	1978
(6)	Dennis et al.	Evolutions of Electrofulguration in Control of Bleeding of Experimental Gastric Ulcers	<i>Digestive Diseases and Sciences</i> , Vol. 24, No. 11, 845-848	11/79
(7)	Barry MS et al.	The effect of radiofrequency-generated thermal energy on the mechanical and histologic characteristic of the arterial wall in vivo: Implications for radiofrequency angioplasty	<i>CRC Press, American Heart Journal</i> , Vol. 117, 332-341	2/82
(8)	Swain et al.	Which Electrode? A comparison of four endoscopic methods of electrocoagulation in experimental bleeding ulcers	<i>Gut</i> , 25, 1424-1431	1984
(9)	Robert G. Britain	Letter from Department of Health and Human Services to Jerry L. Malis		4/15/85
(10)	Slager et al.	Vaporization of Atherosclerotic Plaques by Spark Erosion	<i>JACC</i> Vol. 5, No. 6, 1382-6	6/85
(11)	Jerry L. Malis	Letter from Jerry L. Malis to Food and Drug Administration		7/25/85
(12)	Ramsay et al.	A Comparison of Bipolar and Monopolar Diathermy Probes in Experimental Animals	<i>Urological Research</i> 13:99-102	1985
(13)	Leonard I. Malis, M.D.	Instrumentation for Microvascular Neurosurgery	<i>Cerebrovascular Surgery</i> , Vol 1, 245-260.	1985

	Author	Article Title	Source & Page Nos.	Date
(14)	Leonard I. Malis, M.D.	Acoustic Neuroma Surgery		1987
(15)	Slager et al.	Spark Erosion of Arteriosclerotic Plaques	<i>Kardiologie, Kardiol.76: Supp. 6, 67-71 (1987)</i>	1987
(16)	Valleylab, Inc.	Surgistat Service Manual	Valleylab Part Number 945 100 102 A	7/88
(17)	Leonard I. Malis, M.D.	New Trends in Microsurgery and Applied Technology	<i>Advanced Technology in Neurosurgery, 1-16.</i>	1988
(18)	Nardella	Radio Frequency Energy and Impedance Feedback	SPIE Vol. 1068 Catheter-based Sensing and Imaging Technology	1989
(19)	Tucker et al.	A Bipolar Electrosurgical Turp Loop	<i>The Organizing Committee of the 7th World Congress on Endourology and ESWL Foundation for Advancement of International Science</i>	1989
(20)	Tucker et al.	A Comparison of Urologic Application of Bipolar Versus Monopolar Five French Electrosurgical Probes	<i>Journal of Urology</i> Vol. 141, 662-665	3/89
(21)	Lee et al.	Thermal Compression and Molding of Atherosclerotic Vascular Tissue With Use of Radiofrequency Energy: Implications for Radiofrequency Balloon Angioplasty	<i>JACC</i> Vol. 13 No. 5, 1167-75	4/89
(22)	Tucker et al.	In vivo effect of 5 French bipolar and monopolar electrosurgical probes on the porcine bladder	<i>Urological Research</i> 18, 291-294	1990
(23)	Kramolowsky et al.	Use of 5F Bipolar Electrosurgical Probe in Endoscopic Urological Procedures	<i>Journal of Urology</i> Vol. 143, 275-277	2/90
(24)	Kramolowsky et al.	The Urological Application of Electrosurgery	<i>Journal of Urology</i> Vol. 146, 669	9/91

	Author	Article Title	Source & Page Nos.	Date
(25)	Douglas O. Olsen, M.D.	Bipolar Laparoscopic Cholecystectomy	Bipolar Laparoscopic Cholecystectomy Lecture & Videotape	10/7/91
(26)	Carl A. Larson	Letter from Department of Health and Human Services to Jerry L. Malis		4/22/91
(27)	Codman & Shurtleff, Inc.	The Malis Bipolar Electrosurgical System CMC - III Instruction Manual		7/91
(28)		Valley Forge's new products	CLINICA, 475, 5	11/6/91
(29)	Valley Forge Scientific Corp.	Summary of Safety and Effective Information from 510K		At least as early as 1991.
(30)	Codman & Shurtleff, Inc.	The Malis Bipolar Coagulating and Bipolar Cutting System CMC-II brochure		At least as early as 1991
(31)	Leonard I. Malis, M.D.	The Value of Irrigation During Bipolar Coagulation	See ARTC 21602	At least as early as 4/9/93
(32)	ArthroCare	ArthroCare Sept. 93 Investor Video		9/24/93
(33)	Leonard I. Malis, M.D.	New Trends in Microsurgery and Applied Technology	See ARTC 21596-21600	At least as early as 4/9/93
(34)	Leonard I. Malis, M.D.	Excerpted from a seminar by Leonard I. Malis, M.D. at the 1995 American Association of Neurological Surgeons Meeting		1995
(35)	Leonard I. Malis, M.D.	Electrosurgery, Technical Note	J. Neursurg., Vol. 85, 970-975.	11/96
(36)	Ian E. Shuman, DDS, FAGD	Bipolar Versus Monopolar Electrosurgery: Clinical Applications	Dentistry Today, Vol. 20, No. 12	12/01

II. REFERENCES LISTED ON THE PATENTS-IN-SUIT

A. PATENTS

	Country	Patent No.	Date	Name of Patentee
(1)	US	2,050,904	08/11/36	Trice
(2)	US	4,033,351	07/05/77	Hetzel
(3)	US	4,040,426	08/09/77	Morrison, Jr.
(4)	US	4,043,342	08/23/77	Morrison, Jr
(5)	US	4,202,337	05/13/80	Hren et al.
(6)	US	4,228,800	10/21/80	Degler, Jr. et al.
(7)	US	4,240,441	12/23/81	Khalil
(8)	US	4,476,862	10/16/84	Pao
(9)	US	4,532,924	08/06/85	Auth et al.
(10)	US	4,567,890	02/04/86	Ohta et al.
(11)	US	4,593,691	06/10/86	Lindstrom et al.
(12)	US	4,658,817	04/21/87	Hardy
(13)	US	4,682,596	07/28/87	Bales et al.
(14)	US	4,706,667	11/17/87	Roos
(15)	US	4,709,698	12/16/87	Johnston et al.
(16)	US	4,727,874	03/01/88	Bowers et al.
(17)	US	4,736,743	04/12/88	Daikuzono
(18)	US	4,737,678	04/12/88	Hasegawa
(19)	US	4,762,128	08/09/88	Rosenbluth
(20)	US	4,765,331	08/23/88	Petruzzi et al.
(21)	US	4,785,806	11/22/88	Deckelbaum
(22)	US	4,813,429	03/27/89	Eshel et al.
(23)	US	4,860,752	08/29/89	Turner
(24)	US	4,936,301	06/26/90	Rexroth et al.
(25)	US	4,943,290	07/24/90	Rexroth et al.
(26)	US	4,955,377	09/11/90	Lennox et al.
(27)	US	4,967,765	11/06/90	Turner et al.
(28)	US	4,968,314	11/06/90	Michaels
(29)	US	4,998,933	03/12/91	Eggers et al.
(30)	US	5,007,437	04/16/91	Sterzer
(31)	US	5,037,421	08/06/91	Boutacoff et al.
(32)	US	5,057,105	10/15/91	Malone et al.
(33)	US	5,057,106	10/15/91	Kasevich et al.
(34)	US	5,061,266	10/29/91	Hakky
(35)	US	5,078,717	01/07/92	Parins et al.
(36)	US	5,083,565	01/28/92	Parins
(37)	US	5,102,410	04/07/92	Dressel
(38)	US	5,125,928	06/30/92	Parins et al.
(39)	US	5,147,354	09/15/92	Boutacoff et al.

	Country	Patent No.	Date	Name of Patentee
(40)	US	5,151,098	09/29/92	Loertscher
(41)	US	5,176,528	01/05/93	Fry et al.
(42)	US	5,178,620	01/12/93	Eggers et al.
(43)	US	5,190,517	03/02/93	Zieve et al.
(44)	US	5,192,280	03/09/93	Parins
(45)	US	5,195,959	03/23/93	Smith
(46)	US	5,217,455	06/08/93	Tan
(47)	US	5,217,457	06/08/93	Delahuerga et al.
(48)	US	5,249,585	10/05/93	Turner et al.
(49)	US	5,261,410	11/16/93	Alfano et al.
(50)	US	5,267,994	12/07/93	Gentelia et al.
(51)	US	5,267,997	12/07/93	Farin et al.
(52)	US	5,273,524	12/28/93	Fox et al.
(53)	US	5,277,201	01/11/94	Stern
(54)	US	5,281,216	01/25/94	Klicek
(55)	US	5,281,218	01/25/94	Imran
(56)	US	5,282,797	02/01/94	Chess
(57)	US	5,290,273	03/01/94	Tan
(60)	US	5,290,282	03/01/94	Casscells
(61)	US	5,300,069	04/05/94	Hunsberger et al.
(62)	US	5,300,099	04/05/94	Rudie
(63)	US	5,301,687	04/12/94	Wong et al.
(64)	US	5,304,170	04/19/94	Green
(65)	US	5,312,395	05/17/94	Tan et al.
(66)	US	5,312,400	05/17/94	Bales et al.
(67)	US	5,314,406	05/24/94	Arias et al.
(68)	US	5,318,563	06/07/94	Malis et al.
(69)	US	5,322,507	06/21/94	Costello et al.
(70)	US	5,324,254	06/28/94	Phillips
(71)	US	5,326,343	07/05/94	Rudie et al.
(72)	US	5,330,470	07/19/94	Hagen
(73)	US	5,330,518	07/19/94	Neilson et al.
(74)	US	5,334,140	08/02/94	Phillips
(75)	US	5,334,183	08/02/94	Wuchinich
(76)	US	5,336,217	08/09/94	Buys et al.
(77)	US	5,336,220	08/09/94	Ryan et al.
(78)	US	5,342,357	08/30/94	Nardella
(79)	US	5,366,443	11/22/94	Eggers et al.
(80)	US	5,370,642	12/06/94	Keller
(81)	US	5,370,675	12/04/94	Edwards et al.
(82)	US	5,380,277	12/06/94	Phillips
(83)	US	5,380,316	01/10/95	Aita et al.
(84)	US	5,383,876	01/24/95	Nardella
(85)	US	5,383,917	01/95	Desai et al.

	Country	Patent No.	Date	Name of Patentee
(86)	US	5,389,096	02/14/95	Aita et al.
(87)	US	5,395,312	03/07/95	Desai
(88)	US	5,417,687	05/23/95	Nardella et al.
(89)	US	5,419,767	05/30/95	Eggers et al.
(90)	US	5,423,803	06/13/95	Tankovich et al.
(91)	US	5,441,499	08/15/95	Fritzs
(92)	US	5,445,634	08/29/95	Keller
(93)	US	5,496,312	03/05/96	Klicek
(94)	US	5,514,130	05/07/96	Baker
(95)	US	5,556,397	09/17/96	Long et al.
(96)	US	5,569,242	10/29/96	Lax et al.
(97)	US	5,584,872	12/17/96	LaFontaine et al.
(98)	US	5,609,151	03/11/97	Mulier et al.
(99)	US	5,647,869	07/15/97	Goble et al.
(100)	US	5,676,693	10/14/97	LaFontaine
(101)	US	5,681,282	10/28/97	Eggers et al.
(102)	US	5,683,366	11/04/97	Eggers et al.
(103)	US	5,697,281	12/16/97	Eggers et al.
(104)	US	5,697,536	12/16/97	Eggers et al.
(105)	US	5,697,882	12/16/97	Eggers et al.
(106)	US	5,697,909	12/16/97	Eggers et al.
(107)	US	5,700,262	12/23/97	Acosta et al.
(108)	US	5,725,524	03/10/98	Mulier et al.
(109)	US	5,749,869	05/12/98	Lindenmeier et al.
(110)	US	5,766,153	06/16/98	Eggers et al.
(111)	US	5,807,395	09/15/98	Mulier et al.
(112)	US	5,810,764	09/22/98	Eggers et al.
(113)	US	5,860,974	01/19/99	Abele
(114)	US	5,871,524	02/16/99	Knowlton
(115)	US	5,885,277	03/23/99	Korth
(116)	US	5,891,095	04/06/99	Eggers et al.
(117)	US	5,897,553	04/27/99	Mulier et al.
(118)	US	5,902,272	05/11/99	Eggers et al.
(119)	US	5,944,715	08/31/99	Goble et al.
(120)	US	6,004,319	12/21/99	Goble et al.
(121)	US	6,013,076	1/11/00	Goble et al.
(122)	US	6,015,406	1/18/00	Goble et al.
(123)	US	6,027,501	2/22/00	Goble et al.
(124)	US	6,039,734	3/21/00	Goble
(125)	US	6,056,746	5/2/00	Goble et al.
(126)	EP	515 867	12/2/92	Valluvan
(127)	EP	0 597 463	5/18/94	Tierney et al.
(128)	EP	0 703 461 A2	3/27/96	Yates
(129)	EP	0 740 926	11/6/96	Wurzer et al.

	Country	Patent No.	Date	Name of Patentee
(130)	EP	0 740 926 A2	11/6/96	Wurzer et al.
(131)	EP	0 754 437	1/22/97	Goble et al.
(132)	GB	2327350	1/99	Goble et al.
(133)	GB	2327351	1/99	Goble et al.
(134)	GB	2327352	1/99	Goble et al.
(135)	JP	57-57802	4/82	Inoue Kiyoshi
(136)	JP	57-117843	7/82	Nakano Yukiyoishi, Matsuura Masaaki
(137)	WO	90/07303	7/12/90	Janssen
(138)	WO	90/09303	7/90	Dare-Bryan et al.
(139)	WO	91/13650	9/19/91	Cathaud
(140)	WO	92/21278	12/10/92	Edwards et al.
(141)	WO	93/13816	7/22/93	Eggers et al.
(142)	WO	93/20747	10/28/93	Rosar et al.
(143)	WO	94/04220	3/3/94	Edwards et al.
(144)	WO	94/08654	4/28/94	Beuchat et al.
(145)	WO	94/14383	7/4/94	Rudko
(146)	WO	94/14386	7/4/94	Day
(147)	WO	94/26228	11/24/94	Eggers et al.
(148)	WO	95/34259	12/21/95	Desai
(149)	WO	96/00042	1/4/96	Edwards et al.
(150)	WO	97/00646	1/9/97	Goble et al.
(151)	WO	97/647	1/9/97	Goble et al.
(152)	WO	97/24073	7/97	Goble et al.
(153)	WO	97/24993	7/17/97	Goble et al.
(154)	WO	97/24994	7/17/97	Goble et al.
(155)	WO	97/48346	12/97	Goble et al.
(156)	WO	97/48345	12/97	Goble et al.
(157)	WO	98/27879	7/98	Odell et al.
(158)	WO	98/27880	7/2/98	Goble
(159)	WO	99/51155	10/14/99	Goddard et al.
(160)	WO	99/51158	10/14/99	Goddard et al.

B. PUBLICATIONS

	Author	Article Title	Source & Page Nos.	Date
(1)	Rand et al.	Effect of Electrocautery on Fresh Human Articular Cartilage	Journal of Arthroscopic Surgery	1985
(2)	Pearce		Electrosurgery, pp. 17, 69-75, 87	1986
(3)	Buechelt et al.	Excimer laser ablation of fibrocartilage: an in vitro and in vivo study	Lasers in Surgery and Medicine 11:271-279	1991

	Author	Article Title	Source & Page Nos.	Date
(4)	Costello	Nd: YAG laser ablation of the prostate as a treatment for benign prostatic hypertrophy	Lasers in Surgery and Medicine 12:121-124	1992

III. Public Domain Books

B. PUBLICATIONS

	Author	Title	Date	Page Nos.
(1)	John A. Pierce	Electrosurgery	1986	1-251.

IV. Individuals

(1) Eberhard Roos

Address: Ing. VDI Eberhard Roos
Sommelweisstr. 1
D 78532 Tuttlingen
GERMANY

Declaration: Declaration of Eberhard Roos 2/11/2003.

(2) Dr. Kim H. Manwaring

Address: Phoenix Children's Hospital
1919 E Thomas Road
Phoenix, Arizona 85016-7710

(3) Dr. Kenneth Taylor,

Address: 375 Golden Eagle Drive
Broomfield, CO 80020

(4) Dr. Michael Choti,

Address: 600 North Wolfe Street, Halsted 614
Baltimore, Maryland 21287-5614

(5) Jerry L. Malis

Address: 136 Green Tree Road
Oaks, PA 19456

(6) Dr. David Present

Address: Unknown

(7) Ginger More

Address: Unknown

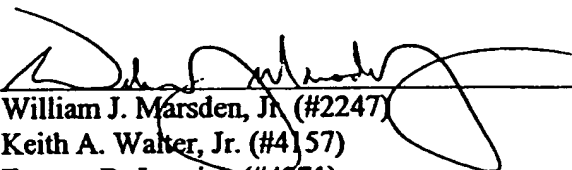
(8) Leonard I. Malis, M.D.

Address: Street Address Unknown
New York City, NY

Dated: March 28, 2003

FISH & RICHARDSON P.C.

By:


William J. Marsden, Jr. (#2247)
Keith A. Walter, Jr. (#4157)
Eugene B. Joswick (#4271)
919 N. Market Street, Suite 1100
P.O. Box 1114
Wilmington, DE 19899-1114
Telephone: (302) 652-5070
Facsimile: (302) 652-0607

Mark J. Hebert
Thomas M. Johnston
225 Franklin Street
Boston, MA 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

Kurtis D. MacFerrin
500 Arguello Street, Suite 500
Redwood City, California 94063
Telephone: (650) 839-5070
Facsimile: (650) 839-5071

Attorneys for Defendant
SMITH & NEPHEW, INC.

CERTIFICATE OF SERVICE

I hereby certify that on this 28th day of March, 2003, a true and correct copy of the SMITH & NEPHEW'S NOTICE PURSUANT TO 35. U.S.C. § 282 was caused to be served on the attorneys of record at the following addresses as indicated:

BY HAND DELIVERY

Jack B. Blumenfeld, Esq.
Morris, Nichols, Arsht & Tunnell
1201 North Market Street
P.O. Box 1347
Wilmington, DE 19899-1347

Attorney for Plaintiff
Arthrocare Corporation

**BY FACSIMILE AND
FEDERAL EXPRESS**

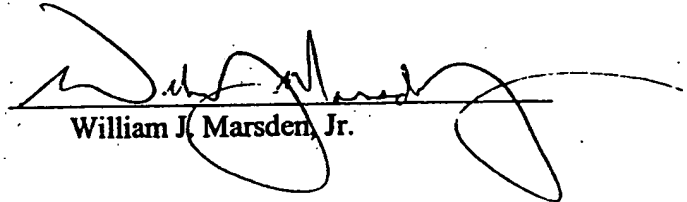
Matthew D. Powers, Esq.
Jared Bobrow
Perry Clark, Esquire
Weil, Gotshal & Manges LLP
201 Redwood Shores Parkway
Redwood Shores, CA 94065

Attorneys for Plaintiffs
Arthrocare

BY HAND DELIVERY

Steven J. Balick, Esq.
Ashby & Geddes
222 Delaware Avenue, 17th Floor
P. O. Box 1150
Wilmington, DE 19899

Attorney for Plaintiff/Counterclaim
Defendant
Ethicon, Inc.


William J. Marsden, Jr.

This Page Blank (uspto)